

II. REMARKS

Claims 74-101 are pending in the subject application. Claims 74-77, 89, 90, and 93-101 have been finally rejected. Claims 78-88, 91 and 92 are objected to. By this Supplemental Amendment, claims 74 and 93-101 have been amended. The amendment of these claims is not intended to be a dedication of any subject matter of these claims. Applicants reserve the right to file one or more of the claims as originally presented in a later filed continuation application. These amendments were made in a sincere effort to place the application in condition for allowance or in better form for consideration on appeal. They were not made earlier as it is Applicants' position that the claims as previously presented satisfied the patentability provisions of 35 U.S.C. The amendments also will not necessitate a new search or examination of the claims. For these reasons, entry of the amendments is respectfully requested.

In view of the preceding amendments and the remarks which follow, reconsideration and withdrawal of the objections and rejections of the claims is respectfully requested.

Claim Objections

Claims 78-88 and 91-92 stand objected to for being dependent a rejected base claim. The Office noted however, that the claims but would be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims.

In response to the objection, and without conceding the correctness of the Office's position, these claims have been amended as suggested by the Office. In view of these amendments, reconsideration and withdrawal of the objections to these claims are respectfully requested.

Claim Rejections - 35 U.S.C. § 112

Claims 74-77, 89-90, 93-101 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject

matter which Applicants regard as the invention. In sum, the Office stated that:

- "1. The second R choice is probably miswritten, as what the specification contains is Hydroxymethyl.
2. PEG is not defined in the claim, appearing in the second line of the R definition.
3. The last X choice is wrong; there are too many hydrogens. It should be $\text{CH}_2\text{C}_6\text{H}_4\text{OCH}_2$ or $\text{CHC}_6\text{H}_5\text{OCH}_2$. For whichever choice is made, applicants must show that one of ordinary skill in the art would have known that this choice, and not another, was intended.
4. The "(C₁-C₆)" in the R1 definition is unclear. This gives the number of carbons, but the number of carbons in what? Are these alkyls? Hydrocarbons? Rings?"

Applicants respectfully traverse. With respect to point 1, above, Applicants have amended the claim as suggested by the Office to indicate hydroxymethyl. Support for the second R choice is found in the application papers on page 20, fourth structure on the right hand column, wherein the structure is shown as:



With respect to point 2, the claim has been amended to define the term "PEG" in the text of the claim. Support for this amendment is found in the application on page 16, line 4. With respect to point 3, the claim has been amended to correctly identify the structure shown on page 14, lines 12 and 13. With respect to point 4, the claim, the claim has been amended to identify this as a C1 to C6 alkyl. Support for this amendment is found in the application papers on page 16, lines 2 through 4.

Claim 94 and 98 also stand rejected under 35 U.S.C. § 112, first paragraph, on the ground that the specification, while being enabling for the scope of claim 99, allegedly does

not reasonably provide enablement for microorganisms generally. The Office commented that alternatively Applicants can insert the word "bacterial" as had been done with e.g. claim 41.

In response to this rejection, but without conceding the correctness of the Office's position, the claims have been amended as suggested by the Office.

Claims 74-76, 89-90, 93-101 further stand rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for other choices, does not reasonably provide enablement for second R choice. The Office argued that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. This choice does not appear in the specification, which has instead the Hydroxymethyl.

Applicants have amended the claim as requested by the Office. Removal of this rejection is respectfully requested.

Claims 74-77, 89, 93-101 also stand rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for other choices, allegedly does not reasonably provide enablement for the third R1 choice.

Applicants respectfully traverse. The claim has been amended to remove this ground for rejection. Removal of this rejection is respectfully requested.

In view of the preceding amendments and remarks, reconsideration and withdrawal of the rejections of the claims is respectfully requested.

III. CONCLUSION

If a telephone interview would advance prosecution of the subject application, the Examiner is invited to telephone the undersigned at the number provided below.

In the unlikely event that the transmittal letter is separated from this document and/or the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and they authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 50-2518**, referencing billing number **7008382001**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Date: October 27, 2004

By: 
Antoinette F. Konski
Reg. No. 34,202

Bingham McCutchen LLP
Three Embarcadero Center, Suite 1800
San Francisco, California 94111
Telephone: (650) 849-4950
Telefax: (650) 849-4800